

of the present application is requested.

## II. OBJECTIONS TO THE CLAIMS

The Examiner has objected to claim 17 based on an informality. Claim 17 has been amended in accordance with the Examiner's suggestion to remove the informality.

## III. REJECTION OF CLAIMS 10-17 UNDER 35 U.S.C. § 103(a)

Claims 10 to 17 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 5,825,643 to Dvorak et al. ("Dvorak") in view of U.S. Patent No. 5,038,246 to Durivage III ("Durivage").

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F. 2d 931, 934 (Fed. Cir. 1990); In re Bond, 910 F. 2d 831, 834 (Fed. Cir. 1990). Additionally, the reference should be considered as a whole, and portions arguing against and "teaching away" from the claimed subject matter must be considered. See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 919 F.2d 720 (Fed. Cir. 1986). In this context, a reference may be said to "teach away" from the claimed subject matter when a person having ordinary skill in the art is discouraged from following the direction set out in the reference or is led in a different direction from the one taken by the applicant. See In re Gurley, 27 F.3d 551 (Fed. Cir. 1994).

Independent claim 10 recites an electronic tripping device for low-voltage circuit-breakers that includes adjusting devices for tripping parameters, key switch adjusting elements and display elements that cooperate with the adjusting devices and are mounted at an operating face of the tripping device.

It is respectfully submitted that there is no suggestion to combine the Dvorak and Durivage references with

regard to the claimed subject matter because the primary Dvorak reference specifically teaches away from mounting adjusting elements and display elements at an operating face of the tripping device as recited in claim 10. To the contrary, Dvorak states that "switches [used to set circuit breaker characteristics, see. col. 1, lines 17-18] add significant bulk to the trip unit package *and there exists a distinct need to eliminate the switches.*" Col. 1, lines 21-23. (emphasis added). Thus, by consulting the Dvorak reference, the skilled practitioner would be led in a different direction from the one taken by the applicant, and would instead be encouraged to use a separate transportable programming device. A key difference between the Dvorak and the claimed subject matter is that when the programmable device according to Dvorak is removed from the tripping device, the tripping device cannot be adjusted, nor can the adjusted parameters be displayed on the tripping device.

Furthermore, the Dvorak reference also teaches away from the claimed subject matter in that eliminating the switches from the tripping device also removes any motivation to replace conventional operating elements such as rotary coding switches, or DIP switches with key switches as recited in claim 10.

For at least these reasons, considered as whole, the primary Dvorak reference teaches away from the claimed subject matter, and therefore cannot render obvious the subject matter of claim 10.

As claims 11 to 17 depend from claim 10, the arguments presented above in connection with claim 10 apply equally to claims 11-17.

Withdrawal of the rejection of claims 10-17 under 35 U.S.C. § 103 as being obvious over the Dvorak patent in view of the Durivage patent is, therefore, requested.

#### **IV. REJECTION OF CLAIM 18 UNDER 35 U.S.C. § 103(a)**

Claim 18 stands rejected under 35 U.S.C. § 103(a), as being unpatentable over Dvorak et al. in view of Durivage in further view of what the Office Action characterizes as.

"admitted prior art".

Claim 18 depends from claim 10, the arguments presented above in connection with claim 10 apply equally to claim 18. As indicated above, the Dvorak reference teaches away from the claimed subject matter, and therefore cannot sustain a *prima facie* obviousness rejection.

Withdrawal of the obviousness rejection of claim 18 is therefore respectfully requested.

V. CONCLUSION

In light of the foregoing, Applicants respectfully submit that all pending claims 10-18 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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AMENDMENT VERSION WITH MARKINGS SHOWING CHANGES MADE

Please amend claim 17 as follows:

17. (Amended) The electronic tripping device according to claim 15, wherein the bar displays have differing heights according to a parameter value to be displayed, an upper end of the bar [indication] indicating a value to be adjusted at the scale.